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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,050	04/08/2004	James Teague	9423.0014-01	7330

22852 7590 12/27/2006
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

MENDOZA, MICHAEL G

ART UNIT	PAPER NUMBER
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3734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/820,050

Applicant(s)

TEAGUE ET AL.

Examiner

Michael G. Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-87 is/are pending in the application:
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/8/04 10/4/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

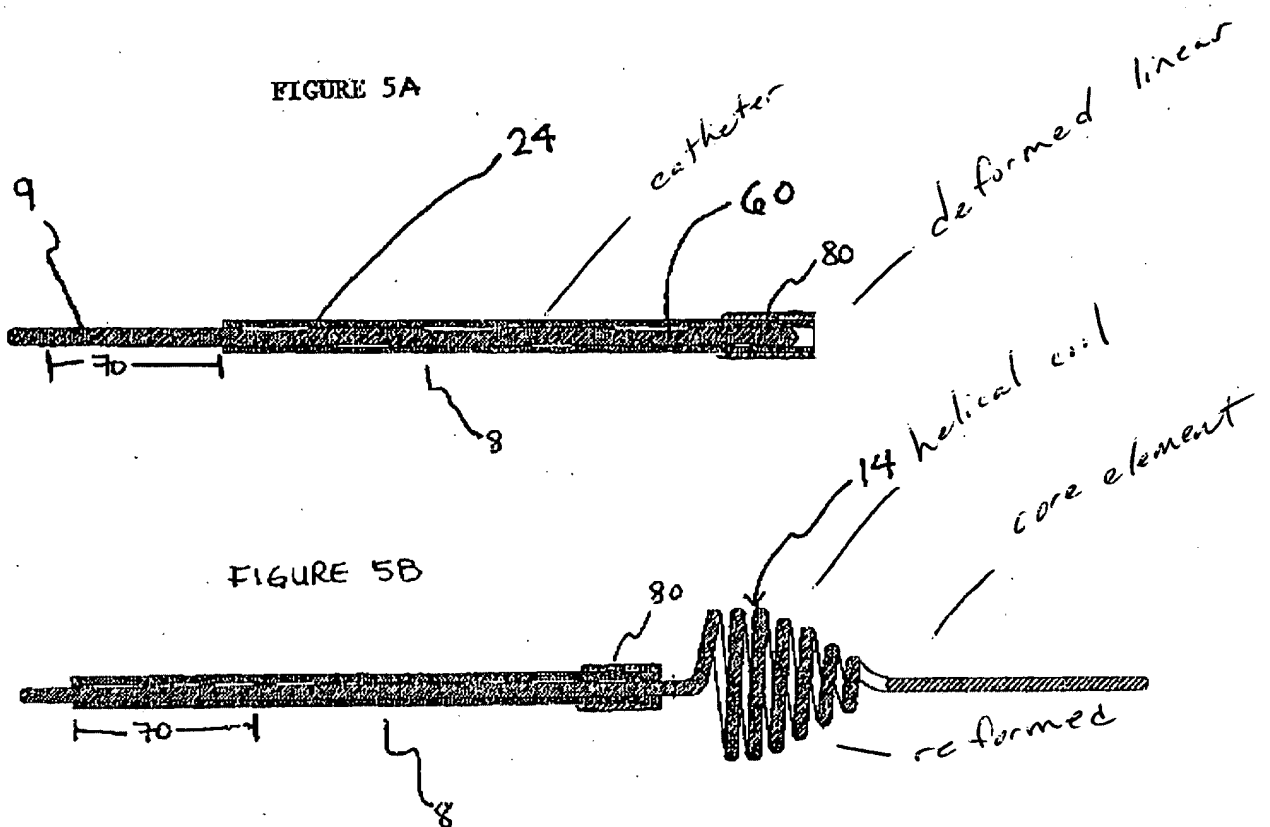
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 55, 56, 58, 62-68, 70, 74-77, 83-87 are rejected under 35 U.S.C. 102(e) as being anticipated by Dretler et al. US 2001/0031974 A1.
3. Dretler et al. teaches a medical device comprising: a core element including a first portion extending substantially longitudinally and a second portion including at least one loop and a helical coil tapering from a larger diameter at a proximal end thereof to a smaller diameter at a distal end thereof, wherein the at least one loop is located at a distance from the proximal end of the helical coil that is substantially greater than a distance between wound sections of the helical coil; wherein the core element comprises a shape-memory material; wherein the helical coil is adapted to ensnare objects in an anatomical lumen; wherein the helical coil and that at least one loop substantially deform upon being subjected to a force along a longitudinal axis of the core element; wherein the helical coil and the at least one loop substantially reform upon cessation of the force exerted along the longitudinal axis of the core element; wherein the helical coil and the at least one loop substantially reform upon cessation of

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the force exerted along the longitudinal axis of the core element; wherein the helical coil and the at least one loop are reversibly transformed into a substantially linear configuration; a catheter adapted to receive the core element; wherein the helical coil assumes a substantially linear configuration when positioned within the catheter and expands back into a tapered configuration upon removal from the catheter; a sheath substantially covering the second portion of the core element; wherein the sheath comprises a polymeric material; wherein the distal portion of the elongate core includes a coating having a color different from that of the sheath; wherein the proximal portion of the elongate core includes a coating having a color different from that of the coating covering the distal portion of the elongate core; wherein the coating comprises one of PTFE, EPTFE, ETFE, or a combination thereof [0032]; and wherein the core is formed at least in part of nickel-titanium alloy [0029].



4. Claims 69, 71, and 72 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dretler et al.

5. Claims 69, 71, and 72 are product-by-process claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. The claimed product appears to be the same or similar to that of the prior art, although produced by a different process. The applicant teaches a polymeric coating/sheath that is heat-shrunk on the core element. The prior art teaches a polymeric coating/sheath that is sprayed onto the core element. Both processes result in a similar product, a core element covered by a polymeric material.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 55-85 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 8-14, and 17-30 of U.S. Patent No. 6740096. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structural limitations set forth in claims 55-85 of the instant application are also claimed in the patent, e.g. claims 1-4, 8-14, and 17-30 of the patent discloses similar limitations, e.g., a core element including a first portion and a second portion including at least one single loop and a helical coil, the helical coil tapering from a larger diameter at a proximal end thereof to a smaller diameter at a distal end thereof, a flat wire wrapping the first and second portions, and a coating/sheath.

8. Claims 86 and 87 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 8-14, and 17-30 of U.S. Patent No. 6740096 in view of Dretler et al. US 2001/0031971 A1.

9. The patent teaches all of the limitations of claims 55-85. It should be noted that the patent does not specifically claim coating being PTFE (TEFLON), EPTFE, ETFE, or a combination thereof, or at least part of the core being of nickel-titanium alloy (NITINOL). However, it is well known to use TEFLON as a coating on the coils of expanding filters and traps to reduce friction when sliding the devices out of a catheter or sheath as evidenced by Dretler et al [0032]. It is also well known to use NITINOL as the material used in devices the require a shape memory such as the device taught by Dretler et al [0029].

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

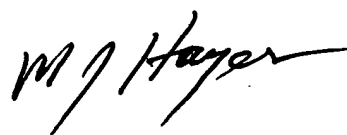
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MM



MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER